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Jari Helin

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EXAMINER

LAU, JONATHAN S

ART UNIT

PAPER NUMBER

1623

NOTIFICATION DATE

DELIVERY MODE

01/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

ADVISORY ACTION

This Office Action is responsive to Applicant's Amendment AFTER FINAL and Remarks, filed 30 Dec 2009.

This application is the national stage entry of PCT/FI03/00734, filed 06 Oct 2003; and claims benefit of foreign priority document FINLAND 20021772, filed 04 Oct 2002. This foreign priority document is in English.

Claims 94-96 and 98-117 are pending in the current application. Claims 106-116, drawn to non-elected inventions, are withdrawn. Claims 96 and 101, drawn to non-elected species, are withdrawn.

Continuation of 3.

Applicant's proposed Amendment AFTER FINAL, filed 30 Dec 2009, will NOT entered because since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal.

Continuation of 5.

Rejections Withdrawn

Applicant's Remarks, filed 30 Dec 2009, with respect to claims 102 rejected under 35 U.S.C. 112, second paragraph, as being indefinite has been fully considered

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and is persuasive, as Applicant's remarks are persuasive that the recitation of "bitter taste" and "undesired color" are properties of the levoglucosan recited in claim 102 and therefore the claim particularly points out and distinctly claims the subject matter that results in the terms cited. Therefore, read within the specific context of claim 102, the cited terms are not indefinite.

This rejection has been **withdrawn**.

Applicant's Remarks, filed 30 Dec 2009, with respect to claims 94, 95, 98-100, 102-105 and 117 rejected under 35 U.S.C. 103(a) as being unpatentable over Kanie et al. (Solid Support Oligosaccharide Synthesis and Combinatorial Carbohydrate Libraries, 2001, p239-256, of record) in view of Rennhard (US Patent 3,766,165, issued 16 Oct 1973, of record) and in view of Tibor Mora et al. (US Patent 2,719,179, of record) has been fully considered and is persuasive, as Applicant's remarks are persuasive that there is no reasonable expectation of success in combining Kanie et al., using an activation group at the C1 position of donor carbohydrate and a protecting group at the C1 position of the acceptor carbohydrate with Rennhard or Tibor Mora et al., using non-activated/non-protected materials in view of the different chemistries understood by one of ordinary skill in the art.

This rejection has been **withdrawn**.

Continuation of 11.

The following rejections detailed in Office Action mailed 24 Jun 2009 are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Amended Claims 94, 95, 98-100, 102-105 and 117 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making those glycoconjugates having a well-known utility, does not reasonably provide enablement for the full scope of the glycoconjugates made by said method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the products made by the instant invention commensurate in scope with these claims. Absent a well-known, or specific and substantial utility, one of skill in the art would not know how to use the products made by the full scope of the instant method.

Response to Applicant's Remarks:

Applicant's Remarks, filed 30 Dec 2009, have been fully considered and not found to be persuasive.

Applicant notes that the claimed methods do not yield a single, specific molecule, and the utility of the claimed methods resides in their production of complex oligosaccharide mixtures. As previously addressed in Applicant's Remarks filed 03 Apr 2009, in which Applicant noted that the products made by the scope of the instant

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method may be used as fingerprinting molecules that are useful to identify products for quality control or marking purposes, this utility does not meet the requirement of a specific utility, as this utility applies to the general class of materials having different molecular weights that may be distinguished. Therefore enablement for this utility does not constitute enablement for using the products made by the scope of the instant method having a well-known or specific and substantial utility.

Applicant interprets rejection as implying that the claimed method would only be patentable if they resulted in the production of a single specific molecular product. However, previous remarks regarding single specific products are drawn to the acknowledgment that specific molecular products encompassed within the compounds made according to the instantly claimed method have a well-known utility. With regard to a mixture of products, the instant claims encompass mixtures made according to the instantly claimed method that lack either a well-known or specific and substantial utility as stated in the Office Action mailed 24 Jun 2009.

Applicant appears to interpret the statement in the rejection "The scope of the claims is infinite. Any possible chemical structure could potentially be used as the glycoconjugate made by the instant method." as encompassing any possible molecule, implying that the breadth of the claim encompasses molecules other than said glycoconjugate. To clarify, the breadth of the claims is limited to the glycoconjugate made by the instant method, and therefore limited to those that would react according to the instant method. However, even this scope is infinite, as any possible saccharide according to groups A-E or oligosaccharide or polysaccharide containing any one of

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said saccharide, resulting in an oligosaccharide or polysaccharide of any size is encompassed within this method.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan S. Lau whose telephone number is 571-270-3531. The examiner can normally be reached on Monday - Thursday, 9 am - 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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